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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,140	04/23/2004	Takashi Okazoe	252019US0CONT	7426
22850	7590	03/29/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				HU, HENRY S
ART UNIT		PAPER NUMBER		
		1713		

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C21

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/830,140	OKAZOE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Henry S. Hu	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on IDS of January 6, 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-18 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

1. It is noted that USPTO has received a total of five IDS' filed on January 6, 2006 (1 page), September 6, 2005 (1 page), July 12, 2004 (1 page), June 23, 2004 (1 page) and April 23, 2004 (1 page) respectively. **Claims 1-18** with a total of seven independent claims (**Claims 1, 10-12, 15 and 17-18**) are pending now. An action follows.

## DETAILED ACTION

### *Election/Restrictions*

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following:

I. **Claims 1-9**, drawn to a method of making a fluorosulfonyl group-containing compound (**5**) from fluorination of staring compound (**3**) into compound (**4**) and then decomposing compound (**4**).

II. **Claim 10**, drawn to a method of making compound (7-1) from thermally decomposing compound (5-1).

III. **Claims 11-17**, drawn to a method of making a fluorosulfonyl group-containing homo- or co-polymer having repeating units of compound (7-1).

IV. **Claim 18**, drawn to a total four-step synthesis of a specific compound (7-10) from starting compound (3-10) via (4-10), (5-10) and (6-10) but no reaction conditions are shown.

3. The inventions are distinct, each from the others because of the following reasons:

**Inventions I, II, III and IV are all unrelated.** Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different same functions, or different effects (MPEP § 806.04, MPEP § 808.01). Although some of fluorinated compounds in all invention groups may involve the same chemical reaction(s) as well as carrying the same or similar repeating fluorinated units, they are actually quite different method or process of making. In a very close examination, the process of making is unique and thereby not interchangeable.

4. In the instant case **Group I** was drawn to a two-step process to make compound (5), **Group II** was drawn to a one-step process to prepare compound (5-1), **Group III** was drawn

to a process of making a homo- or co-polymer from the type of monomer (7-1), while **Group IV** was drawn to only a four-sequence of compounds (3-10 to 7-10) and not showing any condition for organic reaction. Therefore, the scope of the claims, i.e., the metes and boundaries are distinct. **Seven** independent claims (Claims 1, 10-12, 15 and 17-18 marked with underline) are now pending.

5. In the instant case, the copolymers or homopolymers from Invention III may contain repeating units from Inventions I, II and IV. However, the individual property of monomers will not be shown in its polymers mainly due to tremendous difference in molecular weight. Additionally, a monomer may be used as a regular organic compound rather than be used as a monomer for polymerization. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "**special technical features**" shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I and II do

not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons: Claims 1-18 may be either obvious or anticipated by following **JP-05-213929 Kazuya et al., JP-2002-260705 to Assignee Asahi Glass and WO 80/56694 to Okazoe et al.** as well as from other references to prepare similar types of fluorinated monomers, each individually or in combination. In summary, these methods have no common features in the preparation as well as its application since **they are different methods and thereby making different products.** The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate

7. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. It is noted that no phone call was made to **Daniel R. Evans (registration # 55,868, tel: 703 413-3000)** by the examiner due to the complexity on this particular PCT case. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

11. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103.** The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

Patent Examiner, Art Unit 1713, USPTO

March 24, 2006



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